Clark v. The Walt Disney Company et al Doc. 55

**UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF OHIO
EASTERN DIVISION**

AARON CLARK and JOHN PEIRANO, Plaintiffs, v. **THE WALT DISNEY COMPANY; JAKKS PACIFIC, INC.; PLAY ALONG TOYS; KB TOYS; TOYS 'R' US; BABYUNIVERSE, INC.; ETOYS DIRECT, INC.; DISNEY SHOPPING, INC.,** Defendants.	Case No. 2:08-CV-00982 Judge Holschuh Magistrate Judge Abel

DEFENDANTS JAKKS PACIFIC, INC., PLAY ALONG TOYS, TOYS 'R' US, AND DISNEY SHOPPING, INC.'S SUPPLEMENTAL REPLY MEMORANDUM OF LAW IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT

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DEFENDANTS' SUPPLEMENTAL REPLY MEMORANDUM OF LAW IN SUPPORT OF DEFENDANTS' MOTION FOR SUMMARY JUDGMENT

Pursuant to this Court's Order on June 19, 2009 ("Order") (Dkt. # 48), Defendants JAKKS Pacific, Inc., Play Along Toys, Toys 'R' Us, and Disney Shopping, Inc.[1] (collectively "Defendants") respectfully submit this Supplemental Reply Memorandum of Law in Support of their Motion for Summary Judgment on patent infringement claims asserted by Plaintiffs Aaron Clark ("Clark") and John Peirano (collectively "Plaintiffs").

I. INTRODUCTION

The Court converted Defendants' Motion to Dismiss Pursuant to Federal Rule of Civil Procedure 12(b)(6) ("Motion") (Dkt. # 11) into a motion for summary judgment because it found that the prosecution history for the patent-in-suit, U.S. Patent No. 5,548,272 (the "'272 patent"), was relevant to the Court's construction of the "housing" claim element at issue in Defendants' Motion. *See* Order at 11 (Dkt. # 48). Because portions of the prosecution history were not attached to the Complaint, in their Opposition to Defendants' Motion to Dismiss ("Opp.") (Dkt. # 19), Plaintiffs urged the Court to ignore the prosecution history, or, in the alternative, allow Plaintiffs to provide supplemental briefing. *Id.* at 2-4. The Court granted Plaintiffs' request to supplement. *See* Order at 12-13 (Dkt. # 48).

Plaintiffs' supplemental memorandum in opposition to Defendants' motion for summary judgment ("Supplemental Opposition" or "Supp. Opp.") (Dkt. # 54) included 106-pages of material, but only 4-pages actually related to the prosecution history. *See id.* at 17-20. In those

[1] When Defendants originally filed their Motion to Dismiss on January 2, 2009, Disney Shopping, Inc. ("DSI") had not yet been named as a defendant. While the Motion was pending, Plaintiffs amended their complaint three times, adding DSI as a defendant in the Second-Amended Complaint on May 6, 2009 (Dkt. # 45). Although its response to the Complaint is not yet due, DSI hereby joins both the original motion and this supplemental reply memorandum in support of summary judgment.

4-pages, Plaintiffs failed to address the one issue that was highlighted by the Court's Order: The impact of Clark's amendment of his pending claims to avoid rejection on the Court's claim construction. *See* Order at 11 (Dkt. # 48). Instead, Plaintiffs misapply Federal Circuit authority, misrepresent the facts, misunderstand the implication of words added during prosecution, and, again, request the Court ignore the prosecution history, *see* Supp. Opp. at 20 (Dkt. # 54), all in an attempt to avoid summary judgment. Plaintiffs' briefs in opposition to Defendants' Motion for Summary, however, have two glaring and fatal holes.

First, Plaintiffs' claim construction—which is the focus of their Supplemental Opposition—completely ignores the language added to the claims during prosecution requiring that the housing be prepared with "matching art" that is "substantially the same as" the poster art that the "housing covers." Instead, Plaintiffs attempt to distract the Court with frivolous arguments in the hope that the Court will not notice that this key limitation—discussed in detail in Defendants' briefs and noted by the Court in its Order—is entirely read-out of the claims by Plaintiffs' flawed construction.

Second, Plaintiffs concede that if the '272 patent claims simply mean what they say, then there is *no way* that the accused products[2] can infringe. Indeed, Plaintiffs do not even attempt to argue that the accused products contain a housing prepared with "matching art" that is "substantially the same as" the art that the "***housing covers***." This failure to even allege, let alone muster *any* evidence in support of, supposed infringement is fatal under the plain language of the claims.

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[2] Copies of photographs of the nine accused posters are attached as Ex. 1 to the Declaration of Michael J. Song (the "Song Decl."), submitted herewith. Plaintiffs' insinuation that there may be other accused products, *see* Supp. Opp. at 27 n.8 (Dkt. # 54), is unsupported by the evidence. *See* JAKKS Response to Interrogatory No. 2 [Supp. Opp. at Ex. C (Dkt. # 54-13)].

In the end, Plaintiffs' arguments are just irrelevant background noise. The truth is that this case should have never been filed, as a simple review of the accused products and the patent-in-suit conclusively demonstrates that there is no possibility of infringement. Plaintiffs have forced Defendants to spend hundreds of thousands of dollars defending themselves against this clearly frivolous lawsuit. The Court should do justice by terminating this case once and for all.[3]

II. SUMMARY OF PARTIES' CLAIM CONSTRUCTION POSITIONS

For the Court's convenience, the parties' claim construction positions regarding the "housing" claim element, and the disputed terms therein, are set forth in Table 1 below.

Table 1: Claim Construction Positions On "Housing" Claim Element[4]

Claim Language	Plaintiffs' Construction	Defendants' Construction
wherein a surface of said housing is prepared with a	the color, finish, and surface artwork of the housing	wherein a surface of the housing is prepared with a
matching art which is ***substantially the same as*** that area of said poster art which appears on said portion of said poster that said ***housing covers*** when said housing is attached to said poster,		***matching art*** which is ***substantially the same as*** that area of the poster art which appears on the portion of the poster that the ***housing covers*** when the housing is attached to the poster,
such that said housing ***artistically blends in*** with the surrounding poster art that is ***not covered*** by said housing.	form a ***harmonious visual effect*** with the ***art on the poster***.	such that the housing ***artistically blends in*** with the surrounding poster art that is ***not covered*** by the housing.

Table 1 clearly shows that Plaintiffs' construction ignores explicit limitations in the "housing" claim element. In contrast, Table 1 demonstrates that Defendants' position on claim construction is that the words simply mean exactly what they say, and that no special construction is required. *See also* Motion at 7-8 (Dkt. # 11); Reply at 6-7 (Dkt. # 22).

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3 Defendants served Plaintiff Clark and his counsel with a Rule 11 motion at the inception of this case, and will file the motion shortly following the filing of this brief.

4 *See* '272 patent at 3:6-12; Supp. Opp. at 8 (Dkt. # 54); Motion at 7-8 (Dkt. # 11).

III. RELEVANT FACTS IN THE PROSECUTION HISTORY OF THE ’272 PATENT

On March 10, 1995, Clark (through counsel) filed a patent application with the U.S. Patent and Trademark Office (“PTO”), which included 11 claims. *See* Kinsel Decl., Ex. 5 at 43-65 (Dkt. # 11-7). The claims at issue in the instant litigation—claims 1 and 5—were originally filed as claims 1 and 8 in Clark’s application. *Id.* at 50-51.

In the first Office Action on October 10, 1995, the examiner rejected all 11 claims as obvious in view of prior art, specifically, U.S. Patent No. 4,934,079 (“Hoshi”).[5] *Id.* at p. 67-71. With respect to original claim 1, the examiner stated that Hoshi disclosed the claimed poster, speaker and electric circuit, but not the claimed blister pack with matching art.[6] *Id.* at 68. The examiner further stated:

> However, as shown in figure 11, Hoshi suggests that the electrical components are housed in a housing on the back of the poster. The claimed ***blister pack matching the art work of the poster lacks criticality*** because the housing in Hoshi would still ***serve the same function*** as a housing for the electrical components.

Id. (emphasis added).

On January 10, 1996, Clark filed an Amendment and Remarks in response to the examiner’s October 10, 1995 office action. *Id.* at 73-77.[7]

On January 23, 1996, Clark and the examiner conducted an interview where “[a]greement … was reached with respect to some or all of the claims in question.” *Id.* at 78. Specifically, the

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5 A copy of U.S. Patent No. 4,934,079 (“Hoshi”) is attached as Exhibit 2 to the Song Decl.

6 The examiner’s statement that Hoshi disclosed a poster, speaker, electric circuit, and a housing, demonstrates that Plaintiffs’ statement, “At the time Clark invented his talking poster, there was no such thing as a talking poster industry or even a talking poster,” *see* Supp. Opp. at 5 (Dkt. # 54), is either mere puffery or a blatant misrepresentation.

7 The remarks made by Clark in the January 10, 1996 Amendment and Remarks are set forth in Defendants’ Motion, and are thus, not repeated here. *See* Motion at 10 (Dkt. # 11).

examiner described the "general nature of what was agreed to" as "to add ***limitation to the claim*** such that to emphasize the blister pack is printed so that it ***blends*** in with the artwork at the area ***where the blister pack is attached to***." *Id.* (emphasis added).

On March 13, 1996, Clark filed a Supplemental Amendment, which he stated was "***in response*** to the Examiner's Office Action mailed on October 10, 1995, and [was] supplemental to the response filed by Applicant on January 10, 1996, ***which has not yet been considered***." *Id.* at 79 (emphasis added). Clark also stated that "[t]he claims have been amended to more clearly describe the invention and put the claims into the form discussed at the interview." *Id.* at 82.

After Clark's March 13, 1996 Supplemental Amendment, on April 2, 1996, the examiner allowed original claims 1 and 8, which were renumbered as issued claims 1 and 5. *Id.* at 84.

IV. THE PROSECUTION HISTORY OF THE '272 PATENT ONLY SUPPORTS DEFENDANTS' CONSTRUCTION

For the Court's convenience, Plaintiffs' construction of the "housing" claim element in view of the file history, is set forth in Table 2 below.

Table 2: "Housing" Claim Element in Prosecution History and Plaintiffs' Construction[8]

Original Claim	Issued Claim	Plaintiffs' Construction
"…wherein said ***blister pack***	"… wherein a surface of said ***housing*** is prepared with a ***matching*** art which is ***substantially the same as*** that area of said poster art which appears on said portion of said poster that said ***housing covers*** when said housing is attached to said poster,	"the color, finish, and surface artwork of the ***housing***
matches the ***artwork of the poster*** to which it is attached …"	such that said housing ***artistically blends in*** with the ***surrounding poster art*** that is ***not covered*** by said housing."	form a ***harmonious visual effect*** with the ***art on the poster***."

[8] *See* Kinsel Decl. Ex. 5, at 50, 73-74, 79-80; '272 patent at 3:6-12; Supp. Opp. at 8 (Dkt. # 54).

As shown in Table 2, Clark's amendments during prosecution make clear that there are two different parts of the poster that the Court must consider: (1) the part of the poster that the housing covers; and (2) the part of the housing that is not covered by the housing (*i.e.* the "covers" and "not covered" limitations, respectively).

The first part of the "housing" claim element, the "covers" limitation, recites: "wherein a surface of said housing is prepared with a matching art which is substantially the same as that area of said poster art which appears on said portion of said poster that said housing covers." '272 patent at 3:6-10. This "covers" limitation—which is clearly not met by the accused products in this case—requires that the housing surface be prepared with a "matching art" that is "substantially the same as" the art on the poster that the "***housing covers***."

The second part of the "housing" claim element, the "not covered" limitation, recites: "such that said housing artistically blends in with the surrounding poster art that is not covered by said housing." '272 patent at 3:10-12. This "not covered" limitation—which is the *only* portion of the "housing" claim element that Plaintiffs (or their expert) discuss—requires that the housing surface "artistically blends in with" the art on the poster "***not covered***" by the housing.

As is clear from the fact that ***both*** the "covers" and "not covered" limitations of the "housing" claim element were added during prosecution, ***both*** limitations must be met to prove infringement, which simply cannot be done here.

A. The Claim Terms Added During Prosecution Must Have Meaning and Thus Only Support Defendants' Construction

It is well-settled that every word in a claim is material to defining the scope of the invention and must be given effect. *See Warner-Jenkinson Co. v. Hilton Davis Chem.* Co., 520 U.S. 17, 29 (1997) (noting that each limitation contained in a patent claim is material to defining the scope of the patented invention); *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) (holding that "claims are interpreted with an eye toward giving effect to all terms in the claim.") (citing cases); *Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005) ("A claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so.") (citing cases); *Environmental Instruments, Inc. v. Sutron Corp.*, 877 F.2d 1561, 1564 (Fed. Cir. 1989) ("These words have meaning and must be given effect.") (abrogated on other grounds). In theory, Plaintiffs appear to agree.[9]

Only Defendants' construction, however, considers *both* the "covers" and the "not covered" portions of the "housing" claim element. Under Defendants' construction, the words—including *all* the words added during prosecution—simply mean exactly what they say and no special construction is required.

Plaintiffs, on the other hand, seek to give meaning only to the second portion of the "housing" claim element. *See* Supp. Opp. at 8 (Dkt. # 54); *see also* Opp. at 13-15, 17-20 (Dkt. # 19). Thus, completely disregarding the words added in Clark's amendment, Plaintiffs' construction reads-out the "covers" limitation from the claims.

Plaintiffs' construction thus violates the well-settled, undisputed law that every word in a claim must have meaning. Following this law, courts have repeatedly refused to adopt a claim construction that would read-out express limitations in a claim. *See, e.g., Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 93 F.3d 1572, 1582-83 (Fed. Cir. 1996) (holding that the patentee's infringement argument "invites us to read [a] limitation out of the claim. This we cannot do."); *Texas Instruments Inc. v. ITC*, 988 F.2d 1165, 1171 (Fed. Cir. 1993) ("[T]o construe the claims in the manner suggested by [the patentee] would read an express imitation out of the claims. This we will not do ….").

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[9] Plaintiffs originally stated that "similar," "complimentary," "substantially," "matching" and "blends" all have similar meanings and can be "used interchangeably," but now state they "cannot mean the same thing." *Compare* Opp. at 13 (Dkt. # 19) *with* Supp. Opp. at 9 (Dkt. # 54) (citing cases).

B. The Specification Is Consistent with the Claim Terms Added During Prosecution and Only Supports Defendants' Construction

As set forth in Defendants' prior briefing, the specification supports Defendants' construction according to the plain, ordinary meaning of the words. *See* Motion at 8-9 (Dkt. # 11); Reply at 9 (Dkt. # 22). Indeed, Plaintiffs concede that the '272 patent specification—*i.e.* the preferred embodiment—supports Defendants' construction. *See* Supp. Opp. at 15-17 (Dkt. # 54); *see also* Opp. at 11, 16-18, 20 (Dkt. # 19). Further, Plaintiffs concede that the '272 patent specification "describes only one embodiment—the preferred embodiment," which is described by Defendants' construction. *See* Supp. Opp. at 15 (Dkt. # 54).

Despite these concessions, Plaintiffs argue that the scope of the '272 patent is broader than the lone embodiment described by the specification (and Defendants' construction) based only on two sentences of the ***specification***, which state:

> The present invention relates generally to the art of posters and more particularly to a talking poster that projects a recorded sound using a device that is attached to the poster with material that is painted to match the color scheme of the poster art.
> …
> The scope of the invention is not to be considered limited by the above disclosure, and modifications are possible without departing from the spirit of the invention as evidenced by the following claims.

See Supp. Opp. at 1 (quoting '272 patent at 1:7-11), 16 (quoting '272 patent at 2:18-19) (Dkt. # 54); *see also* Opp. at 5, 11, 16-18, 20 (Dkt. # 19). This language from ***the specification***, however, does not affect the scope of the patented invention. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) ("The written description part of the specification itself does not delimit the right to exclude."). Rather, the words of ***the claims*** define the scope of the invention. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) ("It is a 'bedrock principle' of patent law that 'the claims of a patent define the invention to which the patentee is entitled the right to exclude.'") (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004)); *Vitronics Corp. v.*

Conceptronic, Inc., 90 F.3d 1576. 1582 (Fed. Cir. 1996) ("First, we look to the words of the claims themselves … to define the scope of the patented invention."); 35 U.S.C. § 112.

Further, Plaintiffs' supposed evidence from the specification were part of Clark's *original* application, *see* Kinsel Decl., Ex. 5 at 46, 49 (Dkt. # 11-7), and thus do not account for Clark's narrowing amendment. Accordingly, even if these sentences from the specification supported Plaintiffs' construction, because these sentences are contrary to the claim language and the prosecution history, Plaintiffs' construction must be rejected. *See, e.g.*, *Caouette v. Presby*, No. 98-1145, 98-1226, 1999 U.S. App. LEXIS 16694, at *11-14 (Fed. Cir. July 19, 1999); *Novo Nordisk of N. Am., Inc. v. Genentech, Inc.*, 77 F.3d 1364, 1369 (Fed. Cir. 1996); *In re Geerdes*, 491 F.2d 1260, 1263 & n.1 (C.C.P.A. 1974).

C. The Prosecution History Shows Clark Added a Narrowing Limitation to the Claims And Thus Only Supports Defendants' Construction

As the Court noted, during prosecution of the '272 patent: (1) the examiner rejected Clark's original claims as obvious in view of prior art, (2) Clark amended his claim after receiving the rejection, and (3) the claims were only allowed after Clark's amendment. *See* Order at 11 (Dkt. # 48). As this prosecution history clearly shows, to receive the '272 patent, Clark had to *narrow* his claimed invention by adding words to limit the scope of the claims.

Plaintiffs' claim that the "language was added, not as a limitation but to place further protection against more sophisticated future embodiments," *see* Opp. at 16 (Dkt. # 19), is directly contrary to the prosecution history. Indeed, the Examiner Interview Summary Record stated that the amendments were "to add ***limitation to the claim*** such that ***to emphasize*** the blister pack is printed so that it ***blends*** in with the ***artwork*** at the area ***where the blister pack is attached to***." Kinsel Decl., Ex. 5 at 78 (emphasis added) (Dkt. # 11-7).[10]

As discussed *supra* at § IV.A, Plaintiffs' construction ignores the "covers" limitation. Further, Table 2 shows that Plaintiffs' construction of the issued "housing" claim element has the exact same scope as the original "housing" claim element that was *rejected* by the PTO.

D. Plaintiffs' Arguments on Claim Construction Lack Common Sense

Because the accused posters obviously do not meet the "covers" limitation, Plaintiffs are forced to assault common sense to try to convince the Court to read this limitation out of the claims. To this end, Plaintiffs make essentially three arguments. First, Plaintiffs argue that Defendants miss the "context" of the claims. Second, Plaintiffs argue that Defendants import limitations from the specification. And third, Plaintiffs claim that Defendants have not construed the claims through the "lens" of a person of ordinary skill in the art. Each of these arguments are unsupported by the Federal Circuit authority Plaintiffs themselves cite and ignore the fact that Defendants' construction is based on the plain, ordinary meaning of the words in the claims, and thus, must be rejected.

1. Plaintiffs Cannot Use "Context" to Read-Out Claim Limitations

Plaintiffs argue that construing the claim terms based on their plain, ordinary meaning fails to consider the claims in "context." *See* Supp. Opp. at 3-4, 8, 11-12, 19 (Dkt. # 54). This strange argument rests on a misapplication of the law regarding construing claims in "context."

The cases cited by Plaintiffs stand for the unremarkable proposition that the words of the claims must be considered in "context" with the other words in the claims, the specification, and the file history. *See Philips*, 415 F.3d at 1313-19; *see, e.g.*, *Kyocera Wireless Corp. v. v. ITC*, 545 F.3d 1340, 1347-49 (Fed. Cir. 2008) (construing a claim term narrowly based on other claim terms and the specification); *Hockerson-Halberstadt, Inc. v. Converse Inc.*, 183 F3d 1369, 1374 (Fed. Cir. 1999) ("Proper claim construction, however, demands interpretation of the entire claim in context, not a single element in isolation. Therefore, this analysis cannot end without consideration of the rest of the amendments made during reexamination."). As discussed *supra* at § IV.A-C, only Defendants' construction is supported by the claims, specification and prosecution history.

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[10] Plaintiffs blatantly misrepresent the record by stating that the Examiner Interview Summary Record used the phrase "'artistically blends in with the artwork' ***of the poster***," and not "at the ***area where the blister pack is attached*** to." *See* Supp. Opp. at 18-19 (Dkt. # 54) (emphasis added); *see also* Kinsel Decl., Ex. 5 at 78 (Dkt. # 11-7).

While Plaintiffs cite these cases, Plaintiffs apply the "context" requirement in a way that achieves the exact opposite effect intended by the Federal Circuit. That is, Plaintiffs claim that the phrase "such that said housing artistically blends in with the surrounding poster art that is not covered by said housing" is the "phrase that places the entire limitation in context." Supp. Opp. at 8 (Dkt. # 54). Similarly, Plaintiffs argue that the "intent"[11] of the '272 patent is for a housing that "matches, blends, or is substantially similar – 'housing artistically blends' - into the poster to look attractive." *See* Opp. at 5-6, 13-20 (Dkt. # 19). Plaintiffs then attempt to leverage the phrase "artistically blends" as an excuse to *flatly ignore* all of the other limitations in the claims.

To be sure, Plaintiff would like to read-out the limitation requiring the housing match the art that it covers, but to do so violates the doctrine of "context" Plaintiffs purport to be following. Plaintiffs' use of the doctrine of "context" to ignore express claim limitations, however, was also flatly rejected by the Federal Circuit under the very same doctrine:

[11] In addition, "the inventor's subjective intent is irrelevant to the issue of claim construction." *Cordis Corp. v. Boston Scientific Corp.*, 561 F.3d 1319, 1338 (Fed. Cir. 2009) (quoting *Howmedica Osteonics Corp. v. Wright Med. Tech., Inc.*, 540 F.3d 1337, 1346-47 (Fed. Cir. 2008)); *see also Air Turbine Tech., Inc. v. Atlas Copco AB*, 410 F.3d 701, 714 (Fed. Cir. 2005).

> While certain terms may be at the center of the claim construction debate, the context of ***the surrounding words of the claim*** also must be considered in determining the ordinary and customary meaning of those terms.

ACTV, Inc. v. Hypertv Networks, Inc., 346 F.3d 1082, 1088 (Fed. Cir. 2003) (emphasis added) (citing cases); *see also* Supp. Opp. at 8 (citing same) (Dkt. # 54).

In sum, Plaintiffs' argument misapplies the doctrine of construing claims in "context" by reading-out express limitations in the claims, and thus, must be rejected.

2. Plaintiffs Misunderstand the Law Prohibiting Importation of Limitations from the Specification and its Application in this Case

Plaintiffs argue that construing the claim terms based on their plain, ordinary meaning "would violate the fundamental principle of claim construction against importation of limitations from the specification." *See* Supp. Opp. at 15 (Dkt. # 54); *see also id.* at 13-17; Opp. at 11, 16-18 (Dkt. # 19). Ironically, the only supposed evidence Plaintiffs rely on to try to broaden the claims are sentences from the specification. *See supra* at § IV.B. Nonetheless, Plaintiffs' argument regarding importing limitations from the specification misreads the law, and more importantly, has no application to this case.

The Federal Circuit has stated, "We do not import limitations ***into claims*** from examples or embodiments appearing only in [the specification] …." *JVW Enters., Inc. v. Interact Accessories, Inc.*, 424 F.3d 1324, 1335 (Fed. Cir. 2005) (emphasis added); *see also* Supp. Opp. at 14 (quoting same). In addition, case law suggesting that only "broad and unequivocal" language can limit the scope of an invention to a preferred embodiment only applies where "***the language of the claims*** … might be considered ***broad enough to encompass the feature*** in question." *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001) (emphasis added); *see also* Supp. Opp. at 16 (citing *SciMed*, 242 F.3d at 1343-44).

Plaintiffs misapply this law by failing to recognize that these cases, like all cases, begin with the general rule that the scope of a claimed invention is defined by the words of the claims.

The prosecution history shows that in order to overcome a prior art rejection, the words limiting the scope of the ’272 patent were (1) added ***in the claims***, not in the specification; and (2) were added ***by Clark***, not the Defendants. Again, Defendants’ position is that the claim terms mean what they say, and that no special construction is required. Defendants rely on the specification to ***support***, not limit, their construction of the claims. *See* Motion at 8-9 (Dkt. # 11); Reply at 9 (Dkt. # 22) (“This construction is further ***supported*** …by the [specification]”).

In sum, Plaintiffs’ argument depends on their misunderstanding and misapplication of the law to the facts of this case, and thus, must be rejected.

3. Plaintiffs Badly Misunderstand the Person of Ordinary Skill in the Art Requirement—Shapiro’s Declaration Must be Rejected

Plaintiffs argue that the Court should reject Defendants’ construction because it “makes no attempt to interpret the claim language through the lens of a person of ordinary skill in the art.” *See* Supp. Opp. at 7 (Dkt. # 54); *see also id.* at 3-9, 11-12, 27. In addition, Plaintiffs argue that the Court should adopt its flawed construction because it is supported by the declaration of Ellen Shapiro (“Shapiro”), purportedly a person of ordinary skill in the art. *Id.*; *see also* Shapiro Decl. (Dkt. # 54-2 – 54-11).[12] Both arguments fail.

a) The Meaning of Claim Terms to a Person of Ordinary Skill in the Art May Be Readily Apparent to Lay Persons

Plaintiffs argue that Defendants’ construction—which, again, merely relies on the plain, ordinary meaning of the terms—somehow violates the notion that claims must be construed as understood by a person of ordinary skill in the art. Initially, while it is certainly true that claims must be construed as understood by one of ordinary skill in the art at the time of the application, expert testimony is not required to provide such understanding. Indeed, it is frowned upon as extrinsic evidence. As the Court noted, if the intrinsic evidence "unambiguously define the scope of the patented invention, there is *no need* for the Court to consider *any extrinsic evidence*." Order at 7 (emphasis added) (Dkt. # 48) (citing *Vitronics*, 90 F.3d at 1582).

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[12] Defendants file concurrently herewith a Motion to Strike the Shapiro Declaration.

Moreover, as Defendants and the Federal Circuit have repeatedly stated, "the ordinary meaning of claim language as understood by a person of skill in the art may be readily apparent even to lay judges, and claim construction in such cases involves little more than the application of the widely accepted meaning of commonly understood words." *See* Motion at 6 (quoting *Phillips*, 415 F.3d at 1314); Reply at 6-7 (quoting *Acumed LLC v. Stryker Corp.*, 483 F.3d 800, 805 (Fed. Cir. 2007)). Such is the case here because the claim terms in this case "are not overly complex and contain no technical or scientific terms." Order at 12 (Dkt. # 48).

b) Shapiro's Declaration Is Conclusory and Must be Rejected

In contrast to the unambiguous teaching of the Federal Circuit, Plaintiffs rely heavily on the declaration of an alleged person of ordinary skill in the art.[13] *See* Supp. Opp. at 3-9, 11-12, 27 (Dkt. # 54). The Federal Circuit, however, has held:

> … ***conclusory, unsupported assertions*** by experts as to the definition of a claim term are ***not useful*** to a court. Similarly, a court should ***discount*** any expert testimony that is ***clearly at odds*** with the claim construction mandated by the claims themselves, the written description, and the prosecution history, in other words, with the written record of the patent.

Phillips, 415 F.3d at 1318 (emphasis added). Among other deficiencies, Shapiro's opinion is conclusory and clearly at odds with the intrinsic evidence.

First, Shapiro's opinions are unencumbered by the facts and state only conclusions:

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[13] Plaintiffs claim that the "art" in question is "graphic design" is unsubstantiated, as there is no evidence that Clark is a graphic designer. *See* Supp. Opp. at 6 (Dkt. # 54). Moreover, the "graphic design" art is only applicable to *design* patents, not *utility* patents, *see* 35 U.S.C. § 171.

> Based on a review of the intrinsic record, dictionaries and the aforementioned comparable sources, the meaning of this limitation as understood by a person of ordinary skill in the art is that the color, finish, and surface artwork of the housing form a harmonious visual effect with the art on the poster.

See Shapiro Decl. at ¶ 12 (Dkt. # 54-2). Shapiro, however, identifies *no* portions of the intrinsic record that supposedly support her opinion, presumably because no such support exist. She claims to rely on dictionary definitions, yet fails to provide them. *See id.*, Ex. I (Dkt. # 54-11). The only other evidence she relies on are the color wheel and the Pantone Matching System, neither of which were mentioned anywhere in the claims, specification, or file history, but instead, appear to be plucked out of thin air. Neither Shapiro nor Plaintiffs have identified any basis in law or fact for Shapiro's reliance on these items. In short, there is no basis whatsoever for the Court to consider this extrinsic evidence.

Second, it is hard to imagine an expert's claim construction that would be more at odds with the claims, written description, and the prosecution history. The claims of the patent do not so much as suggest anything about a color wheel or the Pantone Matching System. Moreover, the claims specifically require that the housing surface be prepared with "matching art" that is "substantially the same as" the poster art the "housing covers." Shapiro makes no mention *at all* of the art covered by the housing, but instead, focuses exclusively on showing how the housing surface allegedly matches the portions of the poster that are not covered by the housing. As this "covers" limitation was added to overcome a prior art rejection, this clear disclaimer of scope cannot be ignored as Shapiro has done. In the end, Shapiro's opinion fails for all the same reasons Plaintiffs' construction fails: It fails to consider *all* claim limitations, including the "covers" and "not covered" limitations of the "housing" claim element.

In sum, Shapiro's conclusory, unsupported opinion is clearly at odds with the claims, the specification, and the prosecution history, and thus, must be rejected.

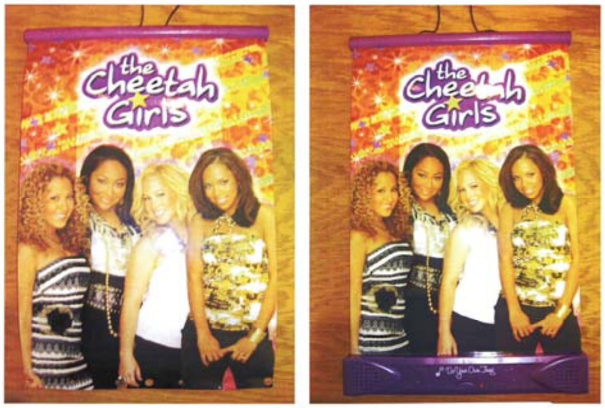
V. THERE IS NO GENUINE ISSUE OF MATERIAL FACT THAT THE ACCUSED POSTERS DO NOT MEET THE "HOUSING" CLAIM ELEMENT AND THUS DO NOT INFRINGE THE '272 PATENT

To grant summary judgment of non-infringement, the Court only needs to find that a single element—the "housing" claim element (including the "covers" limitation)—is missing from the accused products. *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538 (Fed. Cir. 1991) ("There can be no infringement as a matter of law if a claim limitation is totally missing from the accused device."). This missing element is easily proven by: (1) a visual inspection of the accused products; (2) Plaintiffs' concessions; and (3) prosecution history estoppel.

A. Visual Inspection of the Accused Products Shows That the Accused Posters Do Not Infringe

To grant summary judgment, the Court need only visually inspect the surfaces of the housings of the nine accused posters at issue in this case. Photographs of the accused posters, *see* Song Decl. at ¶ 3, Ex. 2, show that the housings are ***not*** prepared with a "matching art" that is "substantially the same as" the "poster art" that the "housing covers," but rather, are painted a monochrome color and placed over the underlying poster art. *See also* Motion at 11 (Dkt. # 11); Reply at 9-10 (Dkt. # 22). The images below, which show two examples of the accused posters with the housings removed, confirm that they do not meet the "housing" claim element.

Hannah Montana
Hannah Montana
Poster with Speaker Attached Poster with Speaker Removed



Poster with Speaker Removed Poster with Speaker Attached

Accordingly, based on a visual inspection, there is no genuine issue of material fact that the accused products do not meet the "housing" claim element. [14]

B. Plaintiffs' Concessions Show That the Accused Posters Do Not Infringe

Plaintiffs (and their expert) have *never* compared the art on the housings of the accused posters to the area of the poster art that the "housing covers." Rather, Plaintiffs (and their expert) have *only* compared the housings of the accused posters to the areas of the poster art ***not covered*** by the housing. *See* Supp. Opp. at 9-10, 25-34, Exs. A (App. B-H), G (Dkt. # 54); *see also* Opp. at 16-21 (Dkt. # 19). Plaintiffs failure to even compare the housings of the accused posters to the covered poster art, let alone allege that the housings of the accused posters contain "matching art" that is "substantially the same as" the art the "housing covers," is a concession that the accused products do not meet this limitation. Accordingly, there is no genuine issue of material fact that the accused products do not infringe the '272 patent.

C. The Prosecution History Estops Plaintiffs from Arguing that the Accused Products Infringe Under the Doctrine of Equivalents

Prosecution history estoppel, a limit on the doctrine of equivalents, precludes Plaintiffs from arguing infringement under the doctrine of equivalents. As stated by the Supreme Court:

> In some cases the Patent and Trademark Office (PTO) may have rejected an earlier version of the patent application on the ground that a claim does not meet a statutory requirement for patentability. … When the patentee responds to the rejection by narrowing his claims, this prosecution history estops him from later arguing that the subject matter covered by the original, broader claim was nothing more than an equivalent.

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722, 727 (2002).[15]

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[14] Although not at issue in Defendants' Motion, Plaintiffs' argument that a jury should determine whether Defendants used "artistic judgment" to make an "aesthetic decision," *see* Supp. Opp. at 31 (Dkt. # 54), demonstrates that their construction would render the claims invalid as indefinite. *See Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350 (Fed. Cir. 2005) (rejecting expert testimony and holding patent invalid as indefinite based on the term "aesthetically pleasing") ("The scope of claim language cannot depend solely on the unrestrained, subjective opinion of a particular individual purportedly practicing the invention.").

Here, the PTO rejected the 11 claims in Clark's patent application as obvious in view of prior art, Clark responded to the rejection by narrowing his claims, and the PTO only issued the '272 patent after the amendment. *See supra* § III, IV (Table 2), IV.C. Accordingly, the prosecution history estops Plaintiffs from arguing that a housing surface that merely "matches the artwork of the poster" (*i.e.* original, broader claim) meets the "housing surface" claim element of the '272 patent under the doctrine of equivalents. But this is precisely what Plaintiffs are trying to do, and they are precluded from doing so under Supreme Court authority.

D. Plaintiffs' Additional Arguments on Infringement Fail

As a last resort, because the accused products obviously do not infringe the '272 patent, Plaintiffs are left with two frivolous arguments. First, Plaintiffs accuse Defendants of comparing the accused products to Plaintiffs' commercial embodiment to prove infringement. Second, Plaintiffs argue they "should be given the opportunity" to provide evidence to rebut the presumption of prosecution history estoppel. These arguments are meritless and fail to raise a genuine issue of material fact. Accordingly, summary judgment of non-infringement is appropriate.

1. Defendants Proved Non-Infringement By Comparing the Accused Products to the Claims, Not Plaintiffs' Commercial Embodiment

Plaintiffs falsely accuse Defendants of improperly comparing the accused products to Plaintiffs' commercial embodiments to prove infringement. *See* Supp. Opp. at 25-26 (Dkt. # 54). But this is just wrong. As required, Defendants compared the accused products to the claims to demonstrate that the accused products cannot possibly infringe the '272 patent. *See* Motion at 11

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[15] Plaintiffs' accusation that "JAKKS misleadingly cropped the above quote from the *Festo* case," misrepresents the facts. *See* Supp. Opp. at 33 (Dkt. # 54). As above, in response to an interrogatory, Defendants quoted page 727, *see also* Dkt. No. 54-13 at 5, whereas Plaintiffs quoted page 741, which is *fourteen* pages later. *See* Supp. Opp. at 33 (Dkt. # 54).

(Dkt. # 11); Reply at 2-3, 9-10 (Dkt. # 22). At most, Defendants used the Ricky Martin poster as an illustration of the visual effect of its construction based on the plain, ordinary meaning of the claim terms. Moreover, although Plaintiffs claim that this poster is protected by the ’272 patent, *see* Opp. at 8 (Dkt. # 19), and improperly attempt to use its posters and licenses as evidence of infringement,[16] *see* Supp. Opp. at 2-3 (Dkt. # 54), as discussed *supra* at § V.A-C, the Court already has everything it needs to determine that the accused posters do not infringe.

2. The Accused Products Are Not Unforeseeable Equivalents

Plaintiffs allege that even if prosecution history estoppel applies, summary judgment should be denied because they “should be given the opportunity to rebut this presumption by offering expert testimony and … other extrinsic evidence” that “the alleged equivalent would have been unforeseeable at the time of the narrowing amendment.” *See* Supp. Opp. at 33-34 (Dkt. # 54). These arguments fail.

First, in a motion for summary judgment, once Defendants showed that there is an absence of evidence to support Plaintiffs’ case, Plaintiffs were required to offer “specific facts showing that there is a genuine issue for trial.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986) (quoting FED. R. CIV. P. 56(e)). That an issue *may* have factual inquiries does not meet this requirement, and thus, does not preclude summary judgment.

Second, there is nothing unforeseeable about Defendants’ accused posters. Clark drafted a claim that would cover the accused products. That claim recited a “housing that matches the artwork of the poster,” and was *rejected* by the examiner. *See supra* at § III, IV (Table 2), IV.C.

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[16] Plaintiffs also improperly attempt to use its commercial embodiments and licenses as evidence of validity which is not at issue in this Motion. *See* Supp. Opp. at 3 (Dkt. # 54).

Thus, there is no scenario in which the accused products could possibly be considered unforeseeable—as they were, in fact, foreseen.[17]

VI. CONCLUSION

For all of the reasons stated above and in Defendants' prior briefs, the Court should grant Defendants' Motion for Summary Judgment of Non-Infringement.

Dated: August 24, 2009

Respectfully submitted,

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[17] Although not at issue in Defendants' Motion, Plaintiffs' claim construction would render the claims invalid as obvious as shown by: (1) the examiner's rejection of Clark's original claims as obvious; and (2) Plaintiffs reliance on the color wheel and Pantone Matching System, developed in the 19th century and 1965, respectively, to determine the "harmonious visual effect" element that is the only purported novelty of Clark's invention. *See* Shapiro Decl. at ¶¶ 8-9 (Dkt. # 54-2); *see also* Opp. at 15 ("In addition, the fact that the housing unit would match or look graphically and artistically attractive to the Talking Posters was ***obvious***.") (emphasis added) (Dkt. # 19). Indeed, the only things "counterintuitive," *see* Supp. Opp. at 2 (Dkt. # 54), are Plaintiffs' examples of non-infringing alternatives. *See id.* at 13.

CERTIFICATE OF SERVICE

I hereby certify that the counsel of record who are deemed to have consented to electronic service are being served today with a copy of this document via the Court's CM/ECF system per Local Rule 5.2. Any other counsel of record will be served by electronic mail, facsimile transmission and/or first class mail on this same date.

Dated: August 24, 2009 /s/ Grant E. Kinsel

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